

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY


(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

REC'D 21 OCT 2005

WIPO

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|   |  |  |                       |
|---|--|--|-----------------------|
| Applicant's or agent's file reference<br>P/63939/J11  | <b>FOR FURTHER ACTION</b>                                |  | See Form PCT/IPEA/416 |
| International application No.<br>PCT/EP2004/051279  | International filing date (day/month/year)<br>28.06.2004 | Priority date (day/month/year)<br>01.07.2003                                 |                       |
| International Patent Classification (IPC) or national classification and IPC<br>H04L12/24, H04J3/16, H04L12/46  |  |  |                       |
| Applicant<br>MARCONI UK INTELLECTUAL PROPERTY et al.  |  |  |                       |
| <p>1. This report is the International preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> sent to the applicant and to the International Bureau) a total of sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p> |  |  |                       |
| <p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and Industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or Industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the International application</p>  |  |  |                       |
| Date of submission of the demand<br><br>25.04.2005  |  | Date of completion of this report<br><br>21.10.2005                          |                       |
| Name and mailing address of the International preliminary examining authority:<br> European Patent Office - P.B. 5818 Patentlaan 2<br>NL-2280 HV Rijswijk - Pays Bas<br>Tel. +31 70 340 - 2040 Tx: 31 651 epo nl<br>Fax: +31 70 340 - 3016   |  | Authorized Officer<br><br>Bernardini, A<br><br>Telephone No. +31 70 340-4209 |                       |



**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/EP2004/051279

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**Box No. I Basis of the report**

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1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
  - ☐ publication of the international application (under Rule 12.4)
  - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements\*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

**Description, Pages**

1-16 as originally filed

**Claims, Numbers**

1-19 as originally filed

**Drawings, Sheets**

1/1 as originally filed

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):

\* If item 4 applies, some or all of these sheets may be marked "superseded."

**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/EP2004/051279

**Box No. V    Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

|                               |      |        |      |
|-------------------------------|------|--------|------|
| 1. Statement                  |      |        |      |
| Novelty (N)                   | Yes: | Claims | 1-19 |
|                               | No:  | Claims |      |
| Inventive step (IS)           | Yes: | Claims |      |
|                               | No:  | Claims | 1-19 |
| Industrial applicability (IA) | Yes: | Claims | 1-19 |
|                               | No:  | Claims |      |

2. Citations and explanations (Rule 70.7):  
see separate sheet

**Re Item V.**

The international examining division has read the communication dated 19 April 2005 and states the following:

The following documents are referred to in this communication:

D1 : WO 02/100024 A (MARCONI COMM INC) 12 December 2002 (2002-12-12)

D2 : US 2002/174207 A1 (BATTOU ABDELLA) 21 November 2002 (2002-11-21)

**1. INDEPENDENT CLAIMS 1,15,16,17,18,19**

The present application does not meet the criteria of Article 33(1) PCT, because the subject matter of claim 1 does not involve an inventive step in the sense of Article 33(3)PCT.

Document D1, which is considered to represent the most relevant state of the art to the subject matter of claim 1, discloses (see page 2 lines 2-14, page 4 line 16 - page 5 line 2, page 5 line 9 - page 6 line 6) a communication system comprising an SDH network and an Ethernet network, the SDH network having a management system to monitor the functionality of the network elements and being arranged to transport Ethernet information in SDH format, where the SDH network comprises a network element arranged to convert the SDH format Ethernet information into Ethernet information.

The subject-matter of independent claim 1 differs from the disclosure of D1 in that the SDH network element making the conversion can request the status of the Ethernet network element, in order to allow the SDH management system to update the status information on the functionality of the SDH network elements and Ethernet network elements.

The problem to be solved by the present invention may therefore be regarded as that of avoiding to extend the SDH network in its entirety to the Ethernet remote site, in order to determine if the Ethernet network elements are functioning correctly.

In view of D2 ( see paragraphs 3,4,8-12,106) the solution proposed in claim 1 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT). The features disclosed in D1 and D2 would be combined by the skilled person, without exercise of any inventive skills in order to solve the problem posed. The proposed solution in independent claim 1 thus cannot be considered inventive (Article 33(3) PCT).

The same reasoning applies, mutatis mutandis, to the subject-matter of claims 15-19

**2. DEPENDENT CLAIMS 2-14**

The subject matter of dependent claims 2-14 is not inventive (Article 33(3) PCT) for the following reasons:

2.1 The features of claims 2,3,4,6,8,10,12-14 are a matter of normal design procedure for the man skilled in the art of SDH transmission networks

2.2 The features of claims 5,7,9,11 do not add anything inventive to the subject matter of the independent claims

3. In relation to the arguments raised by the applicant in the communication, his attention is drawn to additional parts of D2, not previously mentioned in the letter dated 13 December 2004 (see figures 27,28,35,50a, paragraphs 106,151, and paragraphs 118,341).